

REMARKS

The claims remaining in the present application are Claims 1-22. The Examiner is thanked for performing a thorough search. The Examiner is thanked for indicating in paragraph 3 of the Office Action that Claims 1-22 are allowable over the prior art of record on technical merit.

CLAIM REJECTIONS

35 U.S.C. §101

Claims 1-22

In paragraph 2 of the Office Action, Claims 1-22 are rejected under 35 U.S.C. §101 as being unpatentable subject matter. Applicant respectfully traverses this rejection.

Independent Claim 1 recites,

A computer-implemented method for compiling ASL (ACPI Source Language) code into AML (ACPI machine language) code, comprising:
accessing an ASL program;
executing a preprocessor to process the ASL program and to insert support for at least one non-native programming construct; and
processing the ASL program using an ASL compiler to compile the ASL program into a resulting AML program.

Applicant respectfully submits that Claim 1 recites patentable subject matter. 35 U.S.C. §101 states that a new and useful process, machine, manufacture or composition of matter is patentable subject matter. Further, referring to the last paragraph on page 1 of "The Interim Guidelines for Examination of Patent Applications" (referred to hereinafter as "Interim Guidelines"), which appears to have been published October 10, 2005, "the claimed invention" cannot be "an abstract idea, law of nature or natural phenomenon." Claim 1 recites a process. Obviously, the limitations of Claim 1 are not drawn to a law of nature or a natural phenomenon.

Further, the limitations of Claim 1 are not drawn to an abstract idea. For example, the limitations recited by Claim 1 are useful and of real world value. Section A on page 4 indicates that an embodiment that is useful and has real world value is not an abstract idea. Page 4 lines 19 and 20 state, "The applicant is in the best position to explain why an invention is believed useful." The instant application serial number 10/693,510 states on page 5 lines 11-33,

The resulting ASL program produced by the preprocessor is then processed using an ASL compiler to compile the ASL program into a resulting AML

program. For example, the non-native programming constructs included in the ASL program are tolerated by the ASL compiler during its compile process....

In this manner, an ACPI preprocessor in accordance with embodiments of the present invention provides robust support for many types of high level programming constructions that are otherwise unavailable to an ASL software programmer. Access to these high level programming constructs provide a number of advantages. For example, the high level programming constructs make ASL code developed in accordance with embodiments of the present invention much easier to maintain, debug, and develop in comparison to the prior art. Additionally, ASL files developed in accordance with embodiments of the present invention are much more reusable, much more portable across different platforms, and much more sharable, in comparison to the prior art. Importantly, these benefits are provided while maintaining compatibility with widely supported ASL tools, such as, for example, ASL compilers provided by Intel and Microsoft.

Many more examples of usefulness and real world value are described at page 9 line 37 to page 11 line 34 of the instant application. For example, the embodiment recited by Claim 1 enables for future functionality in a flexible manner, enables object names that are longer than four characters, results in an ASL program that is easy to maintain, enables inclusion of C header files, enables sharing C header files, enables reducing the amount of development work, enables computer system platform variants, enables specialized string variables and so on. Referring to page 5 lines 2-3 of the Interim Guidelines indicates that a person of ordinary skill in the art is the test for determining the usefulness of an embodiment. Anyone of ordinary skill in the art would understand the usefulness and the real world value that results from the embodiment recited by Claim 1, which is described by page 5 lines 11-33 and page 9 line 37 to page 11 line 34 of the instant application.

The Interim Guidelines states on page 23 from line 8-11, "One may not patent a process that comprises every 'substantial practical application' of an abstract idea, because such a patent 'in practical effect would be a patent on the [abstract idea] itself.'" Claim 1 recites ASL code, AML code, an ASL program, a preprocessor, non-native programming construct, and a resulting AML program, among other things. For at least this reason, Claim 1 does not comprise "...every 'substantial practical application' of an abstract idea."

Further, the embodiment recited by Claim 1 has concrete results. Page 22 lines 7-9 of the Interim Guidelines indicate that a process that is substantially

repeatable or that substantially produces the same result again has concrete results. Claim 1 recites “accessing an ASL program; executing a preprocessor to process the ASL program and to insert support for at least one non-native programming construct; and processing the ASL program using an ASL compiler to compile the ASL program into a resulting AML program.” The limitations of Claim 1 clearly recite limitations which are substantially repeatable and which can be used to substantially produce the same result, a “resulting AML program,” repeatedly.

Lastly, the embodiment recited by Claim 1 produces tangible results. Page 22 line 2 indicates that an embodiment produces tangible results if it produces a “beneficial result or effect.” As already stated, the instant application describes many beneficial results or effects at page 5 lines 11-33 and page 9 line 37 to page 11 line 34.

The Examiner may think that by quoting parts of the instant application that describe usefulness, real world value, or beneficial results or effects, that Applicant is importing limitations from the specification into the claims. This is not the case. By reciting “accessing an ASL program; executing a preprocessor to process the ASL program and to insert support for at least one non-native programming construct; and processing the ASL program using an ASL compiler to compile the ASL program into a resulting AML program” the embodiment recited by Claim 1 is useful, has real world value and beneficial results which are described by the instant application at page 5 lines 11-33 and page 9 line 37 to page 11 line 34.

The Office Action states, “Practical application can be provided by a physical transformation on a useful, concrete and tangible result. No physical transformation is recited and additionally, the final result of the claim is a preprocessor which is not a tangible result because results are not tangible embodied on a computer readable medium.” Applicant respectfully submits that this is a misinterpretation of the Interim’s Guidelines. Abstract ideas, laws of nature and natural phenomenon are not patentable subject matter. However, referring to page 18 line 1 and 2 and page 18 lines 9-11 a practical application of an abstract idea, law of nature, or natural phenomenon may be deserving of patent protection. Applicant reiterates that Claim 1 is not an abstract idea, law of nature or natural phenomenon.

Section 2 of the Interim Guidelines, which starts on page 29, provides instructions on determining "...Whether the Claimed Invention is a Practical Application of an Abstract Idea, Law of Nature, or Natural Phenomenon..." Section 2 specifies two tests for determining whether the claimed invention is a practical application of an abstract idea, law of nature or natural phenomenon. These two tests are (1) transforming an article or physical object to a different state or thing, and (2) determining whether a claimed invention produces useful, concrete and tangible results.

The Office Action indicates that results are not tangible if they are not embodied on a computer readable medium. Applicant respectfully submits that this is a misinterpretation of the Interim's Guidelines. The Interim Guidelines provide instructions for determining whether results are tangible starting at the middle of page 21 to the top of page 22. No where does this section state that results have to be on computer readable medium in order to be tangible. However, this section states that "beneficial results or effects" qualify as "tangible results." The instant application describes beneficial results and effects that are enabled by the embodiment recited by Claim 1, among other places, at page 5 lines 11-33 and page 9 line 37 to page 11 line 34.

For at least these reasons, independent Claim 1 should be patentable subject matter. Further, independent Claims 8, 17 and 21 should be patentable subject matter for similar reasons that Claim 1 should be patentable subject matter.

Claims 2-7 depend on Claim 1. Claims 9-16 depend on Claim 8. Claims 18-20 depend on Claim 17. Claim 22 depends on Claim 21. These dependent claims include all of the limitations of their respective independent claims. Further, these dependent claims include additional limitations which further make them patentable. Therefore, these dependent claims should be patentable for at least the reasons that their respective independent claims should be patentable.

CONCLUSION

In light of the above listed amendments and remarks, reconsideration of the rejected claims is requested. Based on the arguments and amendments presented above, it is respectfully submitted that Claims 1-22 overcome the rejections of record. For reasons discussed herein, Applicant respectfully requests that Claims 1-22 be considered by the Examiner. Therefore, allowance of Claims 1-22 is respectfully solicited.

Should the Examiner have a question regarding the instant amendment and response, the Applicant invites the Examiner to contact the Applicant's undersigned representative at the below listed telephone number.

Respectfully submitted,
WAGNER, MURABITO & HAO LLP

Dated: 10/25, 2006


John P. Wagner Jr.
Registration No. 35,398

Address:

Westridge Business Park
123 Westridge Drive
Watsonville, California 95076 USA

Telephone:

(408) 938-9060 Voice
(408) 234-3749 Direct/Cell
(408) 763-2895 Facsimile